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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,708	07/24/2003	Donald J. Kyle	6750-174-999	8122
20583	7590	04/27/2006		EXAMINER
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				HABTE, KAH SAY
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,708	KYLE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kahsay Habte	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 February 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-96,99-108 and 111-207 is/are pending in the application.
- 4a) Of the above claim(s) 64-84,90-96 and 102-108 is/are withdrawn from consideration.
- 5) Claim(s) 21-60, 62-63,85-89,99-101,111 and 144-207 is/are allowed.
- 6) Claim(s) 1,18,19 and 61 is/are rejected.
- 7) Claim(s) 2-17,20 and 112-143 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/16/06, 2/17/06.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-96, 99-108 and 111-207 are pending in this application.

***Response to Amendment***

2. Applicant's amendment filed 8/9/01 in response to the previous Office Action (Paper No. 3) is acknowledged. Rejections of claims 42-43, 45, 59 and 63 under 35 U.S.C. 103(a) has been obviated. It was argued that the two compounds in Toldy et al. *Acta Chimica Academiae Scientiarum Hungaricae* (1971), 69(2), 221-7: 4-(6-chloro-3-pyridazinyl)-N-(4-ethoxyphenyl)-1-Piperazinecarbothioamide and 4-(6-methoxy-3-pyridazinyl)-N-(4-ethoxyphenyl)-1-Piperazinecarbothioamide are not disclosed in said reference. Applicants question the credibility of the English abstract for Toldy et al. that is provided with the previous Office Action.
3. The examiner requested Chemical Abstract Search in Columbus, Ohio to investigate this matter. The two compounds show up in the search result, but they are not present in the reference.

Upon further review the English translation of Toldy et al. *Acta Chimica Academiae Scientiarum Hungaricae* (1971), 69(2), 221-7, it is deemed necessary to raise new issues that need further rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 18-19 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toldy et al. *Acta Chimica Academiae Scientiarum Hungaricae* (1971), 69(2), 221-7 (English translation attached). Cited reference in English teaches a compound of interest: 4-(6-chloropyridazinyl-3-yl)-N,N-diethylpiperazine-1-carboxamide that has therapeutic benefit for the treatment of TB. Said compound is almost the same as applicants when applicant's formula (III) has the following substituents:

$R^1 = Cl$ ;  $n = m = 0$ ;  $A = NH$ ; and  $R^4 = ethyl$ .

The only difference between the prior art compounds and applicants' compounds is that the position of the chloro substituent on the pyridazinyl ring and the substitution on amino group (i.e.  $A = NH$  vs  $A = N-C_2H_5$ ). The prior art compounds have the chloro and substituent at the 4-position of the pyridazinyl ring, but applicants require that the substituents of  $R^1$  to be fixed at the 6-position of the pyridazinyl ring (i.e.  $R^1 = Cl$  is fixed at 6-position). Thus, the only difference between applicants' compounds and the prior art compounds is the position of the chloro substituents on the pyridazinyl ring. It is well established that position isomers are *prima facie* structurally obvious even in the absence of a teaching to modify. The isomer is expected to be preparable by the same

method and to have generally the same properties. This expectation is then deemed the motivation for preparing the position isomers. This circumstance has arisen many times. See: *Ex parte Englehardt*, 208 USPQ 343, 349; *In re Mehta*, 146 USPQ 284, 287; *In re Surrey*, 138 USPQ 67; *Ex Parte Ullerot*, 103 USPQ 185; *In re Norris*, 84 USPQ 459; *Ex Parte Naito*, 168 USPQ 437, 439; *Ex parte Allais*, 152 USPQ 66; *In re Wilder*, 166 USPQ 545, 548; *Ex parte Henkel*, 130 USPQ 474; *Ex parte Biel*, 124 USPQ 109; *In re Petrzilka*, 165 USPQ 327; *In re Crownse*, 150 USPQ 554; *In re Fouche*, 169 USPQ 431; *Ex parte Ruddy*, 121 USPQ 427; *In re Wiechert*, 152 USPQ 249, *In re Shetty*, 195 USPQ 753.

For example, "Position isomerism has been used as a tool to obtain new and useful drugs" (Englehardt) and "Position isomerism is a fact of close structural similarity" (Mehta, emphasis in the original). See also MPEP 2144.09, second paragraph.

The second difference between applicants and the prior art compound is in the definition of variable A. Applicants' compounds have -NH-, but the prior art compound has -N-C<sub>2</sub>H<sub>5</sub>. Compounds that differ only by the presence or absence of an extra methyl group or two are homologues. Homologues are of such close structural similarity that the disclosure of a compound renders *prima facie* obvious its homologue. The homologue is expected to be preparable by the same method and to have generally the same properties. This expectation is then deemed the motivation for preparing homologues. Of course, these presumptions are rebuttable by the showing of unexpected effects, but initially, the homologues are obvious even in the absence of a

specific teaching to add or remove methyl groups. See *In re Wood*, 199 USPQ 137; *In re Hoke*, 195 USPQ 148; *In re Lohr*, 137 USPQ 548; *In re Magerlein*, 202 USPQ 473; *In re Wiechert*, 152 USPQ 249; *Ex parte Henkel*, 130 USPQ 474; *In re Fauque*, 121 USPQ 425; *In re Druey*, 138 USPQ 39. In all of these cases, the close structural similarity between two compounds differing by one or two methyl groups was itself sufficient to show obviousness.

#### ***Objection***

5. Claims 2-17, 20 and 112-143 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Allowable Subject Matter***

6. Claims 21-60, 62-63, 85-89, 99-101, 111 and 144-207 are allowed.

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte  
Primary Examiner  
Art Unit 1624

KH  
April 26, 2006